REMARKS

This amendment is responsive to the Office Action dated March 12, 2003. Applicants have amended claims 1 and 6 to correct typographical errors. Claims 1-24 are still pending.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claim(s) 1-24 under 35 U.S.C. § 102(b) as being anticipated by two Veitch articles. Applicants respectfully traverse the rejection.

The Examiner has plainly failed to establish a prima facie case of unpatentability. After citing section 102, the Examiner set out the following rationale for rejection of claims 1-24, which Applicants reprint here in its entirety:

> Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Veitch articles.
>
> See Introductions, experimentals, Figures.

It is well established that administrative agencies in general, and the United States Patent and Trademark Office in particular, "must present a full and reasoned explanation of its decision." In re Lee, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002). "This standard requires that the agency not only have reached a sound decision, but have articulated the reasons for that decision." Id. at 1433.

The Examiner did not provide a full and reasoned explanation for the rejection of claims 1-24. In particular, the Examiner did not point out where the elements recited in claims 1-24 appear, nor did the Examiner make any effort to demonstrate how the cited references anticipate Applicants' claims. For this reason, the Examiner's rejection does not give Applicants fair notice of the basis for the rejection as required under the law.

As discussed below, the Veitch articles do not disclose each and every feature of the invention as recited in claims 1-24, as required by 35 U.S.C. § 102(b). For this reason, the rejection of claims 1-24 should be withdrawn.

In order to support an anticipation rejection under 35 U.S.C. § 102(b), it is well established that a prior art reference must disclose each and every element of a claim. E.g., Trintec Indus. Inc. v. Top-U.S.A. Corp., 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). This well-

known rule of law is c mm nly referred to as the "all-elements rule." If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. § 102(b) is improper.

The Veitch articles fail to disclose or suggest any relationship between thickness of a permeable magnetic underlayer and a gap in a recording head, as recited in claims 1-7 and 14-21.

In particular, the Veitch articles fail to disclose or suggest a recording layer having a thickness less than or equal to one-half the width of the gap, as recited by Applicants' claims 1-7. Furthermore, the Veitch articles fail to disclose or suggest a thickness of the recording layer that is selected as a function of the width of a gap on a recording head, as recited in claims 14-19. Moreover, the Veitch articles fail to disclose or suggest a method that includes applying a recording layer to a permeable magnetic underlayer and regulating the thickness of the recording layer as a function of the width of a gap on a recording head, as recited in claims 20-21. For at least these reasons, the rejections to claims 1-7 and 14-21 should be withdrawn.

In addition, the Veitch articles fail to disclose or suggest a magnetic recording medium that includes a recording layer, a substrate, and a permeable magnetic underlayer between the recording layer and the substrate, as recited in claims 8-13. For this reason, the rejections to claims 8-13 should be withdrawn. Claims 6 and 14-19 likewise recite a recording medium that includes a recording layer, a substrate, and a permeable magnetic underlayer. Accordingly, the rejections to claims 6 and 14-19 should also be withdrawn.

Furthermore, the Veitch articles fail to disclose or suggest passing a recording field through a recording layer of a magnetic recording medium and regulating the shape of the recording field with a permeable magnetic underlayer, as recited in claims 22-24. The rejections to claims 22-24 should therefore be withdrawn. Also, the Veitch articles also fail to disclose or suggest regulating horizontal or perpendicular components of a magnetic field, as recited in claims 2, 9, 23 and 24. For this additional reason, the rejections of those claims should also be withdrawn. Moreover, the Veitch articles also fail to teach or suggest altering the recording field by generating an image recording field as recited in claim 10, and the rejection of claim 10 should be withdrawn.

The Veitch articles fail to disclose a number of features set forth in claims 1-24. For at least these reasons, the Examiner has failed to establish a prima facia case for anticipation of

Applicants' claims 1-24 under 35 U.S.C. § 102(b). Accordingly, withdrawal of these rejections is requested.

All claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to Deposit Account No. 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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